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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,683	09/22/2003	Folkert W. Horst	U 014830-3	1545

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11/01/2007

EXAMINER

BROWN, VERNAL U

ART UNIT	PAPER NUMBER
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2612

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,683	<b>Applicant(s)</b> HORST ET AL.	
	<b>Examiner</b> Vernal U. Brown	<b>Art Unit</b> 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-21, 25, 29, 31, 33, 35, 37-41 and 43-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-21, 25, 29, 31, 33, 35, 37-41 and 43-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to communication filed on August 15, 2007.

#### ***Response to Amendment***

The declaration made under 37 C.F.R. 1.31 is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of May 22, 2003 for the U.S Patent Application Publication 20040245410 reference. The Affidavit is not sufficient to overcome the rejection because of the following reasons.

The evidence of the conception presented fails to show that that the conception contains all of the claimed subject matter.

Applicant is required to submit evidenced to show that the invention actually worked and was operational in order to claim the active reduction to practice date of May 22, 2003.

In determining priority of invention reasonable diligence must be shown.

The inventor cannot swear behind the reference using 37 C.F.R. 1.31 when the reference claims the same invention (MPEP 715 (11) (B)).

#### ***Allowable Subject Matter***

The indicated allowability of claims 46-49 is withdrawn in view of the newly discovered reference(s) to Jicha et al. (US Patent 6,175,784) and Yamaguchi (US Patent 6,819,259).

Rejections based on the newly cited reference(s) follow.

### ***Response to Arguments***

Applicant's arguments with respect to claims 14-21, 25, 29, 31, 33, 35, 37, 41, and 43-49 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14, 25, 29, 31, 33, 35, 37 and 43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-4, 11, 13-14, 20 and 22-23 of copending Application No. 10/667,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 25, 29, 31, 33, 35, 37 and 43 are broader than the combination of claims 1 and 3-4 or 11 and 13-14 or 20 and 22-23, in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-16, 19-20, 21, 29, 31, 33, 37, 39, 41, 43-44 are rejected under 35

U.S.C. 102(b) as being anticipated by Jicha et al. US Patent 6175784.

Regarding claim 14, Jicha et al. teaches a remote control device for controlling a locomotive, the remote control device comprising:

a first input for receiving a command signal from a user for indicating the command to be executed by the locomotive (col. 3 lines 24-27, col. 9 lines 27-30);

a second input distinct from the first input for receiving user identification data (col. 9 lines 8-26);

processing unit (50) operative to transmit a control signal indicating the command to be executed when the user identification belong to an authorized user (col. 5 lines 51-55, col. 9 lines 11-30).

Regarding claim 15, Jicha et al. teaches a user authentication unit for receiving the user identification data and processing the user identification to generate verification data indicative of whether the user identification data belong to an authorized user (col. 9 lines 8-25).

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Regarding claim 16, Jicha et al. teaches the remote control store data relating to command signal (col. 9 lines 26-42).

Regarding claims 19-20, Jicha et al. teaches the use of a keypad for entering user information (col. 9 lines 27-30).

Regarding claim 21, Jicha et al. teaches the user supplied information is stored in stored in a computer readable medium (58) (col. 5 lines 49-55).

Regarding claim 25, Jicha et al. teaches a remote control device for controlling a locomotive, the remote control device comprising:

a first input for receiving a command signal from a user for indicating the command to be executed by the locomotive (col. 3 lines 24-27, col. 9 lines 27-30);

a second input distinct from the first input for receiving user identification data (col. 9 lines 8-26);

transmitting a control signal over a wireless communication link to the locomotive to be executed when the user identification data belong to an authorized user (col. 9 lines 8-30, col. 3 lines 10-12).

Regarding claims 29 and 31, Jicha et al. teaches a remote control device for controlling a locomotive, the remote control device comprising:

a first input for receiving a command signal from a user for indicating the command to be executed by the locomotive (col. 3 lines 24-27, col. 9 lines 27-30);

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a second input distinct from the first input for receiving user identification data (col. 9 lines 8-26);

processing unit (50) operative to transmit a control signal indicating the command to be executed when the user identification belong to an authorized user (col. 5 lines 51-55, col. 9 lines 11-30);

a user authentication unit for processing the user identification data to generate verification data indicative of whether the user identification data belong to an authorized user (col. 9 lines 8-25).

Regarding claim 33, Jicha et al. teaches a remote control device for controlling a locomotive, the remote control device comprising:

a first input for receiving a command signal from a user for indicating the command to be executed by the locomotive (col. 3 lines 24-27, col. 9 lines 27-30);

a second input distinct from the first input for receiving user identification data (col. 9 lines 8-26);

processing unit (50) operative to transmit a control signal indicating the command to be executed when the user identification belong to an authorized user (col. 5 lines 51-55, col. 9 lines 11-30);

Regarding claim 37, Jicha et al. teaches a remote control device for controlling a locomotive, the remote control device comprising:

a first input for receiving a command signal from a user for indicating the command to be executed by the locomotive (col. 3 lines 24-27, col. 9 lines 27-30);

a second input distinct from the first input for receiving user identification data (col. 9 lines 8-26);

the remote control is adapted to issue a prompt for indicating to a user to provide user identification data processing unit (50) operative to transmit a control signal indicating the command to be executed when the user identification belong to an authorized user (col. 5 lines 51-55, col. 9 lines 11-30).

Regarding claim 39, Jicha et al. teaches the user is prompted to enter his/her identification by the display (col. 9 lines 9-10) that is considered a visual prompt.

Regarding claim 41, Jicha et al. teaches prompting the user with a text message (col. 9 lines 22-25).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jicha et al. US Patent 6175784 in view of Joao US Patent 6542076.



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Regarding claims 17-18, Jicha et al. teaches receiving the user identification data and processing the user identification to generate verification data (col. 9 lines 8-25) but is silent on teaching the identification data includes biometric data. Joao in an analogous art teaches a remote control for a train (col. 21 lines 15-34) and the remote control use biometric data for identifying the user and the biometric data include fingerprint (col. 51 lines 7-15).

It would have been obvious to one of ordinary skill in the art to modify the system of Jicha et al. as disclosed by Joao because the use of biometric identification data serve the purposes of increasing the security of the system and is a more reliable identification means.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jicha et al. US Patent 6175784 in view of Lewis US Patent 6213391.

Regarding claim 35, Jicha et al. teaches a remote control device for controlling a locomotive, the remote control device comprising:

- a first input for receiving a command signal from a user for indicating the command to be executed by the locomotive (col. 3 lines 24-27, col. 9 lines 27-30);

- a second input distinct from the first input for receiving user identification data (col. 9 lines 8-26);

- processing unit (50) operative to transmit a control signal indicating the command to be executed when the user identification belong to an authorized user (col. 5 lines 51-55, col. 9 lines 11-30);

a user authentication unit for processing the user identification data to generate verification data indicative of whether the user identification data belong to an authorized user (col. 9 lines 8-25). Jicha et al. is silent on teaching the identification data includes DNA data. Lewis in an art related remote control invention teaches a remote control that uses DNA identification to authenticate a user.

It would have been obvious to one of ordinary skill in the art to modify the system of Jicha et al. as disclosed by Lewis because the use of DNA identification data serve the purposes of increasing the security of the system and is a more reliable identification means.

Claims 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jicha et al. US Patent 6175784 in view of Dufresne et al. US Patent 5497185.

Regarding claims 38 and 40, Jicha et al. teaches the user is prompted to enter his/her identification by the display (col. 9 lines 9-10) that is considered a visual prompt but is silent on teaching a flashing light as a visual prompt and an audio prompt. Dufresne et al. in an art related invention in the same field of endeavor of remote control teaches the use of an audio and visual prompt with flashing light (col. 9 lines 1-6).

It would have been obvious to one of ordinary skill in the art to modify the system of Jicha et al. as disclosed by Dufresne et al. because a flashing light and audio are alternative means for prompting a user based on the application environment and preferred mode of prompting a user.

Claims 43-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jicha et al. US Patent 6175784 in view of Yamaguchi US Patent 6819259.

Regarding claims 43-45, Jicha et al. teaches a remote control device for controlling a locomotive, the remote control device comprising:

a first input for receiving a command signal from a user for indicating the command to be executed by the locomotive (col. 3 lines 24-27, col. 9 lines 27-30);

a second input distinct from the first input for receiving user identification data (col. 9 lines 8-26);

an user authentication unit for processing the user identification data to generate verification data indicative of whether the user identification data belong to an authorized user (col. 9 lines 8-25);

processing unit (50) operative to transmit a control signal indicating the command to be executed when the user identification belong to an authorized user (col. 5 lines 51-55, col. 9 lines 11-30). Jicha et al. is silent on teaching a transmission termination event that cease the transmission of control signals indicative of the commands to be executed by the locomotive. Yamaguchi in an art related invention in the same field of endeavor of remote control teaches a timing circuit that out put a timing control signal to terminate the transmission of the control signal based on the timer setup value (col. 6 lines 20-25).

It would have been obvious to one of ordinary skill in the art to modify the system of Jicha et al. as disclosed by Yamaguchi because ceasing of the transmission of the control signal provides a means of scheduling the transmission of the control signal and provides more flexibility to the locomotive remote control system.

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Regarding claims 46-47, Jicha et al. teaches a remote control device for controlling a locomotive (col. 3 lines 24-27, col. 9 lines 27-30) but is silent on teaching the transmission termination event is the expiration of a time delay commencing with the receipt of a signal indicative of the user identification data. Yamaguchi in an art related invention in the same field of endeavor of remote control teaches a timing circuit that out put a timing control signal to terminate the transmission of the control signal based on the timer setup value (col. 6 lines 20-25) and teaches the signal received by the remote control to be transmitted includes identification data (col. 6 lines 45-55).

It would have been obvious to one of ordinary skill in the art to the system of Jicha et al. as disclosed by Yamaguchi because the use of expiration of a time delay commencing with the receipt of a signal indicative of the user identification data as the termination events provides a means of scheduling the transmission of the control signal and provides more flexibility to the locomotive remote control system.

Regarding claims 48-49, Jicha et al. teaches a remote control device for controlling a locomotive (col. 3 lines 24-27, col. 9 lines 27-30) but is silent on teaching the transmission termination event is the expiration of a time delay during which no signal indicative of a command is received. Yamaguchi in an art related invention in the same field of endeavor of remote control teaches a timing circuit that out put a timing control signal to terminate the transmission of the control signal based on the timer setup value (col. 6 lines 20-25) and teaches outputting the control data base on the input data (col. 6 lines 45-67). The remote control transmits data based setup timer value (col. 6 lines 59-62), therefore if there is no data is received in the allotted time the data transmission is terminated. Yamaguchi also teaches resuming the

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transmission of the control signal when a new user identification data is received (col. 5 line 57- col. 6 line 8) as called for in claim 49.

It would have been obvious to one of ordinary skill in the art to the system of Jicha et al. as disclosed by Yamaguchi because the use of the expiration of a time delay during which no signal indicative of a command is received as the termination events provides a means of scheduling the transmission of the control signal and provides more flexibility to the locomotive remote control system.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vernal U. Brown whose telephone number is 571-272-3060. The examiner can normally be reached on 8:30-7:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman can be reached on 571-272-3059. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Vernal Brown  
October 23, 2007



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